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| 09/901,405 | 07/08/2001 | Imran Sharif | UNIQA-0030 | 6474 |

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EXAMINER

JEAN GILLES, JUDE

ART UNIT PAPER NUMBER

2143

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,405

Applicant(s)

SHARIF ET AL.

Examiner

Jude J. Jean-Gilles

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in regards to the Reply received on 01/13/2006.

Response to the Brief on Appeal

1. This action is responsive to the appeal brief filed on 01/13/2006. Claims 1-11 are pending. Claims 1-11 represent a "System and Method for Using an Internet Appliance to Send/Receive Digital Content Files as E-mail Attachments." The Office has reviewed the Brief on appeal and

Response to Arguments

2. Applicant's arguments with respect to claim 1 have been carefully considered, but are not deemed fully persuasive. The Summary of claimed Subject matter states : "Claim 1 defines a system (FIG. 19) for exchanging digital content files as email attachments. The system 1904 includes a system server 1908 and an Internet appliance 1910 - 1914 that communicate via an external communications network 1902. This system structure permits the system server and the Internet appliance, acting as a client (specification at page 5, lines 26 - 27), to divide the task of storing, selecting and downloading user interface screens, creating and editing email, storing, selecting and attaching digital content files to an email, and sending the email with its attachments to an external email server 1906 via the communications network (specification at page 6, lines 1- 5).

Applicant's arguments for appeal are deemed moot in view of the following new ground of rejection as explained here below, necessitated by Applicant argument' main point of contention (i.e., a System and Method for Using an Internet Appliance to Send/Receive Digital Content Files as E-mail Attachments using an external communication network) to the claims which significantly affected the scope thereof.

Drawings

New corrected drawings requested in the first Office Action and submitted on 07/08/2001 are accepted.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson (Dawson) U.S. 6,252,588 B1 in view of Chang et al (Chang) U.S. 6,598,076 B1).

Regarding claim 1: Dawson teaches the invention substantially as claimed. Dawson teaches a system for exchanging digital content files as email attachments (*column 8, lines 1-8*), comprising:

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a system server connected to a communications network and implementing a standard electronic mail protocol for sending and receiving email and digital content email attachments via the communications network (*column 22, lines 13-16; column 20, lines 38-50; fig. 14, items 1431-1435*);

the system server having storage and retrieval means for a plurality of user interface display screens and digital content files (*column 22, lines 62-64*);

an Internet appliance for receiving a reduced keyset keystroke sequence, a connection with the communications network for establishing a client relationship with the system server (*column 22, lines 62-64*), a browser for accessing user interface display screens via the network connection (*column 1, lines 35-53*), a video/audio converter providing output signals compatible with a standard television receiver for display of accessed user interface display screens (*column 8, lines 51-52*), and hyperlink selection means responsive to the received keystroke sequence for navigating an accessed user interface display screen (*column 12, lines 1-8; column 5, lines 51-52*);

the user interface screens and the reduced keyset keystroke sequence defining a text entry and editing protocol, an email creation and addressing protocol, an email viewing protocol, and an email deletion protocol (*column 28, lines 36-57; fig. 18, item 1809*);

the user interface screens and the reduced keyset keystroke sequence also defining an email attachment selection protocol permitting selection of digital content files for attachment to a user created email (*fig. 2, items 200, 216, 218*);

the system server including means responsive to the email attachment selection protocol and the reduced keyset keystroke sequence for retrieving a selected digital content file, and for encoding the retrieved file as a standard email attachment (*fig. 4, items 415-423*);

the system server including means for establishing a connection via the communications network with a standard email server, and for sending the email and encoded attachment to the email server using the standard email protocols (*column 22, lines 13-16; fig. 14, items 1431-1435*);

the system server including means for establishing a connection via the communications network with the email server for receiving email and encoded attachments, for decoding the attachments, for storing the received email and decoded attachment, and for notifying the Internet appliance that an email and attachment has been received (*column 17, lines 22-67; column 18, lines 1-35*).

However, Applicant argues in the Brief on Appeal dated 01/13/2006 that Darson does not specifically teach "a system server connected to a communications network and implementing a standard electronic mail protocol for sending and receiving email and digital content email attachments via the communications network". The Examiner does not agree with the Applicant characterization of the server connected to the communications network and the Dawson implicitly states : "*The SET UP INTERNET ACCESS screen allows the user to specify the necessary parameters and passwords for the system to connect to a communications network such as the internet. The SIMPLE INTERNET SETUP screen also allows the user to specify the necessary*

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parameters and passwords for the system to connect to a communications network, and is used in situations where many of the necessary parameters and passwords are already stored in the system as default values. " Obviously, the server of the system of Dawson is connected to the external communication network or the Internet.

Furthermore, in the same field of endeavor, Chang discloses "Each of the devices 14, 16, 18, 22 and 24 can communicate with one another by sending or receiving an electronic message. The messages are sent to the communication network 12 and are stored on a server computer 26. The messages also may have an electronic attachment attached thereto." [see Chang, column 3, lines 1-28; fig. 1 items 12, 26, and 18; see also column 4, lines 33-49].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Chang's teachings of using "a system server connected to a communications network and implementing a standard electronic mail protocol for sending and receiving email and digital content email attachments via the communications network" with the teachings of Dawson, for the purpose of improving the ability of a network "...to insure that a receiver can open an email with virtually any type of electronic attachment ..." as stated by Chang in lines 16-19 of column 2. Dawson also provides motivation to combine by disclosing a system that "allows those who have never used a computer to easily send messages to anyone with a similar system, or even to other existing systems" as stated by Chang in lines 35-39 of column 7. By this rationale, **claim 1** is rejected.

Regarding claim 2: The combination of Dawson-Chang teaches the system of claim 1, further including hand-held reduced keyset means for creating and transmitting the reduced keyset keystroke sequence (see Dawson; column 30, *lines 46-54*).

Regarding claim 3: The combination of Dawson-Chang teaches the system of claim 2, wherein the hand-held reduced keyset means defines a remote control unit that transmits the reduced keyset keystroke sequence as an infra-red beam, and wherein the Internet appliance is adapted for receiving the infra-red beam (see Dawson; column 30, *lines 46-54*).

Regarding claim 4: The combination of Dawson-Chang teaches the system of claim 2, wherein the hand-held reduced keyset means defines a wireless telephone, and wherein the Internet appliance is adapted for receiving the reduced keyset keystroke sequence from the wireless telephone (see Chang; fig. 1, items 18, 22; column 4, lines 50-67).

Regarding claim 5: The combination of Dawson-Chang teaches the system of claim 1, further including a standard television receiver connected to receive the converted video/audio output signals for display of user interface display screens, and embedded hyperlinks, including system email protocol display screens, received emails, entered text, screens permitting text editing, digital content file selection, and email recipient address selection and entering (see Dawson; column 8, *lines 34-50*).

Regarding claim 6: The combination of Dawson-Chang teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and

keystroke parsing engine for converting a reduced keyset keystroke sequence to text and displaying the text as the body of a new email (see Dawson; column 1, *lines 39-53*).

Regarding claim 7: The combination of Dawson-Chang teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and keystroke parsing engine for interpreting a reduced keyset keystroke sequence as editing commands for entered text within the body of the new email and for displaying an editing process (see Dawson; column 2, *lines 18-26; fig. 3 items 309-311*).

Regarding claim 8: The combination of Dawson-Chang teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and parsing engine permitting a reduced keyset keystroke sequence to access a display of available digital content files, and selecting a digital content file for attachment to a new email (see Dawson; column 2, *lines 18-49; fig. 2, items 216-218; fig. 3, item 304*).

Regarding claim 9: The combination of Dawson-Chang teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and parsing engine permitting a reduced keyset keystroke sequence to display available email recipient addresses to edit a displayed address, and to enter a new email recipient address (see Dawson; column 2, *lines 31-35*).

Regarding claim 10: The combination of Dawson-Chang teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and parsing engine permitting a reduced keyset keystroke sequence to select a display of a list of received emails and email attachments (*fig. 2, items 201, 217*).

Regarding claim 11: The combination of Dawson-Chang teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and parsing engine permitting a reduced keyset keystroke sequence to select and view a received email, and to select and view/listen to email attachments (see Dawson; column 8, lines 9-15).

Conclusion

5. Accordingly, **THIS ACTION IS MADE NON-FINAL**. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jude Jean-Gilles

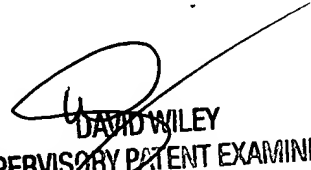
Patent Examiner

Art Unit 2143

JJG



March 29, 2006



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